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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,828	11/28/2000	Masanobu Ninomiya	107971	5519

25944 7590 03/07/2003

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EXAMINER
DOTE, JANIS L

ART UNIT	PAPER NUMBER
1756	13

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Below is a communication from the *EXAMINER* in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
   (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
   (b) ☒ they raise the issue of new matter. (see NOTE below);
   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: See attachment, paragraph 1
4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment, paragraph 2.
7. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection. see attachment, paragraph 3.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
   Claim(s) allowed: 1-6, 12.
   Claim(s) objected to: 11.
   Claim(s) rejected: 7-10, 13, 15-19.
   Claim(s) withdrawn from consideration: 14, 20.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☒ Other: attachment; Interview Summary dated 3/12/03.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1750~~ 1700

FORM PTOL-303 (Rev. 11/00)

1. The proposed amendment to the specification in Table 6 filed after the final rejection in Paper No. 12 on Feb. 24, 2003, raises the issue of new matter. There is no evidence in the originally filed specification showing that the WAXES C, D, and E have the compositions now disclosed in the proposed amended Table 6.

The proposed amendments to claims 13, 15, and 19 raise numerous rejections under 35 U.S.C. 112, second paragraph, rejections under 35 U.S.C. 112, first paragraph, for lack of written description, and the issue of new matter. For example, the proposed amendment to claim 15, "an amount of the toner image formed on the latent image holding member is 0.50 mg/cm^2" (emphasis added), is not adequately described in the originally filed specification. The specification at page 26, lines 15-16, discloses that a "fixed image having a glossiness (75 degree gloss) of 40 to 60 can be formed when the toner carrier amount formed on the recording paper is 0.50 mg/cm" (emphasis added). The originally filed specification discloses fixing a toner image to a recording paper, not to a "latent image holding member." See page 26, lines 5-16. In addition, the proposed amendment also raises a rejection under 35 U.S.C. 112, second paragraph, for lack of unambiguous antecedent basis in claim 13. Claim 13 recites fixing a toner image to a transfer material, not to an electrostatic latent image holding member. It is not clear how a

toner image on an electrostatic latent image holding member has a gloss of 40 to 60 when the image is not fixed to the latent image holding member.

(Applicants in Paper No. 12, page 5, last paragraph, assert that page 45 was amended. However, the amendment filed after the final rejection in Paper 12 did not amend page 45.)

2. The examiner's refusal to the enter the amendment filed after the final rejection in Paper No. 12 renders applicants' arguments with respect to said amendment moot.

Furthermore, the objection to the specification and rejections of claims 18 and 19 under 35 U.S.C. 112, first and second paragraphs, stand for the reasons of record. Applicants' arguments are not persuasive. Applicants assert that "the method to determine hardness does not vary significantly between the different hardness scales" as shown in the DUROMETER manuals. Applicants further assert that "the indication of that it is the Asker C value that is being determined is sufficient to communicate to one of ordinary skill in the art the particular method used in determining the Asker C value." However, the DUROMETER manuals do not support applicants' assertions. At page 2, of the manual labeled "Hardness tester for rubber and plastics," the manual states "[o]ne of the most important steps in using a rubber hardness tester is to select the optimum type.

There are various types of rubber hardness testers available based on different standards applied to a wide variety of subjects to be measured." The manual at page 3, further states that "[e]xpression of hardness is often specified by relative standards." The instruction manual at page 2, item 2.2, states that for hardness type C, "lightly press the pressor foot to the specimen surface under the force of 1 to 1.5 kg with the feel of providing a uniform contact between the pressor foot and the sample surface. Be careful with the soft specimen as the hardness measured will be higher than the true hardness if the specimen is pressed with the excessive force." As discussed in the final rejection, Paper No. 10, paragraph 6, item (2), the evidence discussed in the final rejection shows that there is more than one standard used to determine Asker C hardness values and that the hardness values appear to depend on the load applied. Thus, the evidence on the present record does not support applicants' assertions. Furthermore, as discussed in the final rejection, the specification does not disclose how the hardness values are determined, let alone any standard used to determine the hardness. Nor does the specification disclose the instrument used to determined the hardness. Accordingly, for the reasons discussed in the final rejection, the disclosure in the instant specification does not provide sufficient guidance to a

person having ordinary skill in the art to make or use the claimed invention without undue experimentation.

3. The Rule 132 declaration executed by Masanobu Ninomiya on Feb. 11, 2003, filed in Paper No. 12 on Feb. 24, 2003, has not been considered because it is not considered timely. The declaration is not directed SOLELY to issues which were newly raised by the examiner in the final rejection. The rejection of claims 7-10 over the combined teachings of Shimojo and Nanya was presented in the first office action on the merits mailed May 8, 2002, Paper No. 6. Thus, the rejection over the combined teachings of Shimojo and Nanya was not a new ground of rejection. No new issues of patentability of claims 7-10 with respect to prior art were raised in the final rejection. Applicants could have presented the evidence in the Rule 132 declaration in response to the first office action on the merits in Paper No. 6, prior to the final rejection. Applicants have not shown good and sufficient reasons why the declaration was not earlier presented. Accordingly, this declaration is not timely filed.